



# UNITED STATES PATENT AND TRADEMARK OFFICE

*m*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,689	06/13/2001	Robert D. Fields	10276 (3080-0060	4306

7590 02/25/2004  
Luke A. Kilyk  
KILYK & BOWERSOX, P.L.L.C.  
53A Lee Street  
Warrenton, VA 20186

EXAMINER

DOE, JANIS L

ART UNIT	PAPER NUMBER
----------	--------------

1756

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/880,689

Applicant(s)

FIELDS ET AL.

Examiner

Janis L. Dote

Art Unit

1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment, paragraph 1.

3. ☒ Applicant's reply has overcome the following rejection(s): See attachment, paragraph 2.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment paragraph 3.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 40 and 41.

Claim(s) objected to: 31 and 36.

Claim(s) rejected: 1-30, 32-35, 37-39 and 42.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: See attachment

*Janis L. Dote*  
JANIS L. DOTE  
PRIMARY EXAMINER  
GROUP 1700  
1700

Art Unit: 1756

1. Proposed amended claims 2, 4, 16, 17, and 32, filed after the final rejection on Feb. 3, 2004 (Amdt020304), raise objections under 37 CFR 1.75 to proposed amended claims 4 and 17 and previously presented claims 40 and 41. Proposed amended claims 4 and 17 and previously presented claims 40 and 41 are substantial duplicates of proposed amended claims 2 and 16 and proposed amended claims 32 and 37, respectively. See MPEP § 706.03(k). (Contrary to applicants' statement in Amdt020304, page 12, proposed amended claim 32 does not recite all the limitations recited in previously presented claims 1 and 8.)

Proposed amended claim 14, filed in Amdt020304, raises a rejection of claims 14, 15, 23, and 24 under 35 USC 112, second paragraph, in the limitation phrase "colloidal silica particles are present from about 0.2 wt% to about 0.3 wt% silica, based on the weight of the toner particles" (emphasis added). It is not clear on what the recited weight percentage is based, e.g., the total amount of silica present in the toner particles or the amount of silica present in the surface treatment agent. It is further not clear how said weight percent is also based on the weight of the toner particles. Said limitation also raises the issue of new matter. Applicants have not identified, and the examiner cannot find, any disclosure in the originally filed specification that the internally added colloidal silica is

Art Unit: 1756

present in the amount recited in amended claim 14 based on the total amount of silica present in the toner particles or that the colloidal silica is present in the amount recited in amended claim 14 based on the amount of silica present in the surface treatment agent.

Proposed amended claim 30, filed in Amdt020304, reciting the limitation "said toner particles include a polyethylene wax or a cross-linked styrene-acrylate polymer," raises new issues because said limitation was not present in claim 30 when the final rejection was mailed on Aug. 29, 2003. Said limitation also raises the issue of new matter. The originally filed specification discloses that the toner binder resin may comprise a cross-linked styrene-acrylate. The term "cross-linked styrene-acrylate polymer" recited in amended claim 30 is broader than the disclosed toner resin binder, because it encompasses said polymer being used other than as a toner resin binder, e.g., being used in polymeric surface treatment particles.

2. The rejection of claims 30 and 35 under 35 U.S.C. 102(e)/103(a) over US 6,074,75 (Watanabe), set forth in the final rejection mailed on Aug. 29, 2003 (CTFR082903), paragraph 8, has been overcome. Applicants have provided the

Art Unit: 1756

necessary information, i.e., source and publishing date of Nash reference.

3. The examiner's refusal to enter the amendment filed after the final rejection on Feb. 3, 2004 (Amdt020304), renders applicants' arguments regarding said amendment moot.